

U.S. Application Serial No. 09/911,088
Response to Office Action
Page 4 of 5

REMARKS

Applicants have amended Claims 1, 8, 12-14, 16, and 36, and have canceled Claims 15, 17-35, and 37-66 without prejudice. Enabling support for the amendments can be found in the application as filed, and therefore no new matter is contained in the amendments. Reconsideration of the present application and allowance of resulting Claims 1-14, 16, and 36 is respectfully requested in view of the amendments and following remarks.

I. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-16, 35 and 36 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With regard to Claim 1 and all claims dependent thereon, the Office Action stated that the terms "receptor polynucleotide" and "donor polynucleotide" are unclear. Applicant amended the foregoing to recite "first polynucleotide to be replaced" and "second polynucleotide to replace the first polynucleotide", respectively, in lieu of the objectionable terms. Applicant submits that the amendments overcome the rejections and respectfully requests reconsideration and allowance of the amended claims.

II. Rejections under 35 U.S.C. §112, first paragraph

Claims 1-16, 35 and 36 were rejected under 35 U.S.C. §112, first paragraph as being unpatentable since the specification allegedly does not enable any person skilled in the art to make and use the invention as claimed.

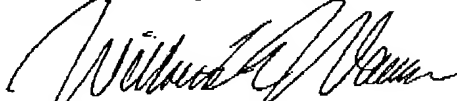
The Examiner stated in telephone interviews with Cary Miller on January 28th and 29th, 2004, that the claims would be allowable if they incorporated a functional limitation. Claim 1 requires "the irreversible recombinase *catalyzes* recombination between the nucleic acids of the IRS and the CIRS and *replacement of the first polynucleotide with the second polynucleotide, thereby forming a replacement construct.*" (Emphasis added). Since Claim 1 requires the replacement of one polynucleotide with another polynucleotide, it currently incorporates a

U.S. Application Serial No. 09/911,088
Response to Office Action
Page 5 of 5

functional limitation. The claims therefore do not read on plant species where such replacement events do not occur.

For at least the foregoing reasons, Applicants respectfully request reconsideration and removal of the rejections and allowance of Claims 1-14, 16 and 36. The foregoing is submitted as a full and complete Response to the Final Office Action mailed November 5, 2003. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment to Deposit Account No. 19-5029. This Response places all claims in the present application in condition for allowance, and such action is courteously solicited. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



By:

William L. Warren
Reg. No. 36,714

Date: February 5, 2004

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, N.E.
Atlanta, GA 30309
(404) 853-8000

SAB Docket: 16313-0052